

Remarks

In the Office Action mailed July 21, 2005 (hereinafter the Office Action), claims 1 through 5 were finally rejected under 35 USC 103(a) as being unpatentable over U.S. Patent 5,028,990 to Kotaki et al (hereinafter the '990 patent) in view of U.S. Patent 5,327,375 to Harari (hereinafter the '375 patent). Claims 6 through 8 had been withdrawn earlier pursuant to an August 25, 2004 election of species requirement. In the Advisory Action mailed September 27, 2005 (hereinafter the Advisory Action), the Examiner maintained the '990 and '375 patents as the basis for the rejection. By this RCE, claims 1 through 4 have been amended to more precisely recite the nature of the charge storage lamina and its relationship to the electrical contact placed in a contact region formed in the charge storage lamina.

In the Office Action, the Examiner conceded at page 3 that the '990 patent "does not disclose a structure such that a substantial entirety of the width of said container region is defined by an upper surface of said patterning stop region." The Examiner then attempted to correct those deficiencies by combining the '900 patent with the '375 patent, noting with particularity that FIG. 8A of the '375 patent teaches that the substantial entirety of the width of the container region is defined by the upper surface of the patterning stop region. The Applicant respectfully disagrees, as a review of FIG. 8A clearly shows that a significant portion of the width of the container region (which extends from the left at **1514l** and from the right at **1515r**) is defined by an upper surface **1512** of the transistor gate rather than the patterning stop region **1502**. In fact, a cursory review of FIG. 8A shows that over half of the width of the container region defined by something other than the patterning stop region **1502** (in this case, the transistor and its insulating layer **1512**), thus making it impossible for FIG. 8A to satisfy the above claim requirement. Such impossibility cannot be reconciled with the requirement set forth in MPEP 2143.03 that all claim limitations must be taught or suggested. Since the combination of the '990 patent and FIG. 8A of the '375 patent fails to teach the limitation that the substantial entirety of the width of the container region is defined by an upper surface of the patterning stop region, the present rejection is defective and should be withdrawn.

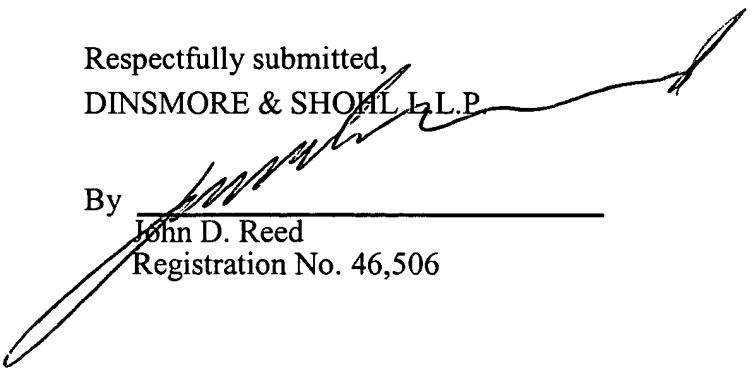
The Examiner also resorts to FIG. 8B of the '375 patent to demonstrate that the claim limitations have been satisfied by its combination with the '990 patent. The present claim amendments recite the nature of the claimed device in more detail, such that even if FIG. 8B does depict the patterning stop region **1602** defining a substantial (or even all of) the width of the container region, there is no teaching in FIG. 8B of an electrical contact formed in a first surface of one of the conductive film layers, shown, for example, as **48** in the Applicant's FIGS. 1G or 2. Specifically, the charge storage lamina (made up of electrodes **P2** and **P3** as well as capacitor layer **C**) of FIG. 8B takes up the entirety of the container region, leaving no room for the electrical contact of the amended claims. This feature, which is clearly recited in the last clause of each of the independent claims as occupying at least a portion of the container region with the charge storage lamina, is neither taught, suggested nor possible in the device of FIG. 8B of the '375 patent. As such, FIG. 8B does not correct the deficiencies of the '990 patent, and accordingly fails the aforementioned MPEP 2143.03 bedrock principle that all of the claim limitations must be taught or suggested. Accordingly, a prima facie case of obviousness is not made out.

The Applicant believes an additional comment about the Examiner's notes in the Advisory Action is warranted. In the Advisory Action, the Examiner states "that by using the flat via in fig. 8B as taught by Harari to replace the via 9 of Kotaki would not change the principle of operation of the primary reference . . . or render the reference inoperable for its intended purpose." The Examiner then cites case law for the proposition that, *inter alia*, lack of bodily incorporation or physical combinability is not destructive of a valid obviousness rejection. The Examiner's position is both true and irrelevant, as the Applicant never argues that such a combination would render the primary reference inoperable or necessitate such bodily/physical incorporation. Instead, the Applicant merely points out in the previous two paragraphs that by not teaching all of the claimed limitations, the purported combination fails one of the basic tenets of a valid obviousness rejection.

Conclusion

In view of the present amendments and remarks, the Applicant respectfully submits that all of the claims are patentable over the cited art, and are entitled to a finding of allowability by the Examiner. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response. Otherwise, early notification of allowable subject matter is respectfully solicited.

Respectfully submitted,
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